

REMARKS

## STATUS OF THE CLAIMS

Claims 1, 3 and 4 are pending in the present matter. The Examiner has objected to claim 3 under 37 C.F.R. § 175(c) as being of improper dependent form. Applicants have amended claim 3 to properly depend from claim 1 and respectfully requests that the Examiner's objections be withdrawn.

## ISSUES UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Schuricht in view of Harris, Jr. et al. Applicants respectfully traverse.

As the Examiner is well aware, to establish a *prima facie* case of obviousness, the Examiner must show that one of ordinary skill in the art would have been suggested or motivated to combine or modify the references' teachings, there must be a reasonable expectation of success from this combination, and the references themselves must teach or suggest all of the claim limitations. Applicants respectfully submit that Harris, Jr. et al. and Schuricht fail to teach all of the claim limitations even when combined and that there is no motivation to combine or modify these references' teachings.

The Examiner contends that Harris discloses a known method of printing mail labels in line with the printed documents to be mailed. Such is not the case. Instead, Harris discloses printing a document off line concurrently with the printing of other personalization information by a printer 42. These pre-printed documents are then sent into a storage area where they may be held until they are required for a particular job order. ('128 patent, column 8, lines 41-64). This is the opposite of what the present invention teaches and claims. Claims 1, 3 and 4 require

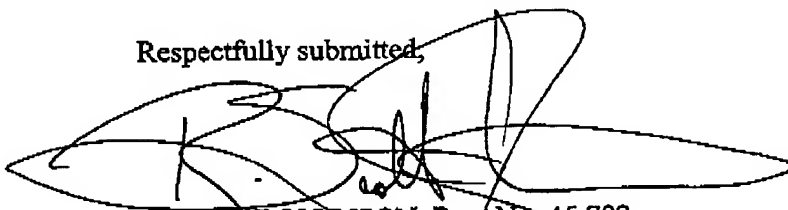
printing each document and printing a shipping label for each document in line with each document. Harris, Jr. et al. teaches the opposite, i.e. printing a label off line.

Moreover, Applicants also respectfully submit that the Examiner has failed to set forth any suggestion or motivation in either Schuricht or Harris, Jr. et al. to combine the references' teachings. Absent any motivation and absent any teaching or suggestion of all of the claim limitations, Applicants respectfully request that the Examiner's rejection of claims 1 and 4 under 35 U.S.C. § 103(a) be withdrawn.

#### CONCLUSION

This is a request under the provision of 37 CFR § 1.136(a) to extend the period for filing a response in the above-identified application for three months from October 20, 2005 to January 20, 2006. Applicant is a small entity; therefore, please charge Deposit Account number 26-0084 in the amount of \$510.00 to cover the cost of the three month extension. Any deficiency or overpayment should be charged or credited to Deposit Account 26-0084. No additional fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Respectfully submitted,



R. SCOTT JOHNSON, Reg. No. 45,792  
McKEE, VOORHEES & SEASE, P.L.C.  
801 Grand Avenue, Suite 3200  
Des Moines, Iowa 50309-2721  
Phone No: (515) 288-3667  
Fax No: (515) 288-1338  
CUSTOMER NO: 22885  
Attorneys of Record

- pw -